

USSN 09/855,403

Amendment responsive to Office Action mailed on March 18, 2005

June 20, 2005

A-1669

REMARKS

Claims 12, 14, 16-18, 21, 25, and 28-31 are canceled and claims 10, 13, 24, 26, and 27 have been amended.

Applicants acknowledge the Examiner's decision to hold new claims 28-31 as withdrawn, based upon a constructive election by original presentation. Accordingly, the withdrawn claims 28-31 have been canceled, without prejudice, in anticipation of their introduction in a future divisional application.

The objection to the specification is now moot, since claim 17, which included the language reciting the exhalation filter in the 3rd port, has been canceled.

Applicants appreciate the Examiner's indication that claims 1-9 are allowed.

Claims 10, 12, 21, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Piper et al. '920. It is noted that claim 21 has been canceled, and claim 24 has been amended to include the limitations of claim 25 (now canceled), so this basis for rejection is moot with respect to those claims. Claim 10 has been amended to include the limitations of claim 12 (now canceled). It is clear that claim 10, as amended, is not anticipated by the Piper et al. reference. The Examiner adopts a strained explanation that the "...adapter could be reversed and attached to an MDI having the same dimension port as that of the nebulizer. Coupling 16 could be removed from 52 and coupling 12 attached to tube 52 while tube 18 could be attached to 16." However, nowhere within the four corners of the Piper et al. '920 patent is this possibility taught, as would be required for an anticipation rejection. The Examiner is merely speculating as to possible ways the device disclosed in the reference could be modified to meet the claim limitations. Clearly, if one has to modify the device to meet the claim limitations, a rejection based upon anticipation under 35 U.S.C. 102(b) is improper and should be withdrawn. Moreover, it would not have been obvious, absent reference to Applicants' teachings, to make the modifications suggested by the Examiner, so even an obviousness type rejection would be improper. Accordingly, Applicants respectfully submit that claim 10 as amended, together with dependent claim 13, are allowable over the Piper et al. reference.

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Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Esbenshade '973. Applicant does not understand why canceled claim 11 was rejected on this basis. However, this rejection is now moot, since claim 10 has been amended to include the limitations of claim 12.

Claim 10 is rejected under 35 U.S.C. 102(e) as being anticipated by Watt '571. This rejection is also moot, since claim 10 has now been amended to include the limitations of claim 12.

Claims 14 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Salter et al. '455. Both of these claims have been canceled, so this rejection is now moot.

Claim 14 is rejected under 35 U.S.C. 102(e) as being anticipated by Salter et al. '234. Since claim 14 has now been canceled, this rejection is moot.

Claims 10, 12, 13, 21, and 24-27 are rejected under 35 U.S.C. 102(f) "because the applicant did not invent the claimed subject matter." Applicants are perplexed by this grounds for rejection. The Examiner does not have the information to make this rejection, and has made incorrect assumptions. As the Examiner should well know, it is not what is disclosed in an application which determines inventorship, but rather what is claimed. Mr. Robert Johnson is a common inventor for both the '932 patent and for the present application, and is the primary inventor for both. Mr. Forchione invented certain aspects of the earlier embodiments disclosed and claimed in the '932 patent, and Mr. DuBose invented a few aspects of the invention claimed in the present application, but Applicants assure the Examiner that the named inventors are the proper ones for the invention claimed in the present application. This rejection is entirely improper and without foundation, and should be withdrawn.

The rejection of claims 14, 16, and 18 under 35 U.S.C. 103(a) as being obvious over Rowland '232 in view of Salter et al. '455 is moot, since these claims have been canceled.

Claims 12-14, 17, 18, 21, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watt '571 in view of Salter et al. '455. Regarding claim 10, now amended to include the limitations of claim 12, Applicants do not understand where in either the Watt or Salter references there is a teaching of a universal adapter having both

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rigid and flexible connector ends for connecting selectively to either an MDI or a nebulizer, as recited in the claim. With regard to claim 24, now amended to include the limitations of canceled claim 25, this claim has been further amended to recite that the engagement flange is adapted to engage inner sidewalls of the spacer member outer body. Clearly, there is no teaching in the cited references of this unique arrangement.

Claims 13, 14, 17, 18, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Piper et al. '920 in view of Salter et al. '455. This rejection falls for reasons similar to those discussed above.

Applicants respectfully submit that this application is in condition for allowance, in view of the amendments and arguments presented above. The Examiner is requested to contact the undersigned at the number below, should any further questions or issues need to be resolved.

Respectfully submitted,



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